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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,568	08/03/2001	Catherine Shoemaker	1960-00100	6318

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CONLEY ROSE, P.C.
P. O. BOX 3267
HOUSTON, TX 77253-3267

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,568

Applicant(s)

SHOEMAKER, CATHERINE

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 22-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Specification fails to support the restrictive limitation of the second side of the label for marking a prescription medicine having *only* a non-textual, descriptive graphic. While applicant does not specifically show the label having textual, descriptive graphics, applicant fails to limit the indicia on the label to non-textual, descriptive graphic indicia. Therefore, the label is capable of receiving non-textual as well as textual, descriptive graphic indicia.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffiths et al. (5,435,600) in view of www.walgreens.com (Walgreens – “Acid Free Printout”).

Griffiths et al. disclose a device for describing prescription medicine contained in a prescription medicine receptacle (40) comprising a label (10) that is capable of being mounted to the receptacle (via adhesive 14 on the bottom surface 13 of the label) having pre-printed indicia (21, 22, 22' – “a line with associated alpha numeric indicia for a doctor's name, a line and associated alpha numeric indicia for a patient's name, and a line and associated alpha numeric indicia for a date” see column 4, lines 59-68 through column 5, lines 1-2) and handwritten indicia (“the doctor's name 42, patient's name 43, and date 44” see column 5, lines 53-57. Griffiths et al. further disclose providing other indicia on the label (see column 5, lines 57-62; inherently, this would include a label having a picture that alone identifies the prescription medicine). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the label, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of label does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for

patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Furthermore, Walgreens.com discloses a device for describing the medicine contained in a medicine receptacle comprising a label having a picture that alone identifies the medicine (Acid Free contains a label having the picture of a user's stomach receiving a chewable tablet that will neutralize the acid in the user's stomach associated with heartburn caused by acidic foods), wherein the label is mounted to a container holding the medicine. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the label of Griffiths et al. to include a picture that alone identifies the prescription medicine in the prescription medicine receptacle, as taught by Walgreens, to provide the user with a method for easily identifying the medicine in the receptacle at a glance.

Regarding claims 20 and 23-26, Griffiths et al., as modified by Walgreens, disclose the picture on the label of the prescription medicine container depicting why the medicine is being used/taken, the symptoms/aliments which the medicine treats and the results of consumption of the medicine (e.g., to neutralize the acid in the user's stomach associated with heartburn caused by acidic foods as seen in Walgreens.com).

Regarding claim 21, Griffiths et al., as modified by Walgreens, disclose the picture on the label of the prescription medicine container depicting the body part for which the medicine is being used (e.g., stomach as seen in Walgreens.com).

Regarding claim 22, Griffiths et al., as modified by Walgreens, disclose a first side (13- bottom surface of Griffith et al.) having an adhering surface (14 – pressure

sensitive adhesive of Griffith et al.) capable of adhering to the prescription medicine container (40); and a second side (12 – top surface of Griffith et al.) having indicia for conveying the type of prescription medicine within the prescription medical container (pre-printed indicia 21, 22, 22' – “a line with associated alpha numeric indicia for a doctor's name, a line and associated alpha numeric indicia for a patient's name, and a line and associated alpha numeric indicia for a date” (see column 4, lines 59-68 through column 5, lines 1-2 and handwritten indicia “the doctor's name 42, patient's name 43, and date 44” see column 5, lines 53-57). Griffiths et al. further disclose providing other indicia on the label (see column 5, lines 57-62; inherently, this would include a label having a non-textual, descriptive graphic that conveys the type of prescription medicine within the prescription medical container).

Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of label does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Furthermore, Walgreens.com discloses a device for describing the medicine contained in a medicine receptacle comprising a label having a picture that alone

identifies the medicine (Acid Free contains a label having the picture of a user's stomach receiving a chewable tablet that will neutralize the acid in the user's stomach associated with heartburn caused by acidic foods), wherein the label is mounted to a container holding the medicine. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the label of Griffiths et al. to include a non-textual, descriptive graphic that conveys the type of prescription medicine in the prescription medical container, as taught by Walgreens, to provide the user with a method for easily identifying the prescription medicine in the container at a glance.

Note: the limitation of the second side having only a non-textual, descriptive graphic has not been fully supported in the specification as set forth in the above 35 U.S.C. 112, 1st paragraph rejections.

Response to Arguments

5. Applicant's arguments with respect to claims 19-26 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the amended claims 19-21 recite the device describing the medicine in a prescription medicine receptacle. While the medicine receptacle of the "Acid Free Printout" does not explicitly disclose a prescription medicine receptacle, Griffiths et al. does disclose providing a device describing the medicine in a prescription medicine receptacle as set forth in the above rejections.

Newly added claims 22-26 are directed to an icon for marking a prescription medicine container wherein the second side has only a non-textual, descriptive graphic.

Applicant argues that the "Acid Free Printout" is not directed to a prescription medicine or medicine receptacle having a side with only non-textual descriptive graphic, since the "Acid Free Printout" label contains text. As stated above, while the "Acid Free Printout" does not explicitly disclose a prescription medicine or medicine receptacle, Griffiths et al. does disclose a prescription medicine and receptacle as disclosed above. Regarding the indicia on the label having only non-textual, descriptive graphic, there is a lack of support for this limitation in the specification as set forth above.

For the reasons as set forth above, the rejections are maintained.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Biava et al. disclose a prescription sheet and medication distribution system.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 10, 2004

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER